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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,887	09/11/2003	Michael J. Czaplicki	1001-067C1	5018
25215	7590	12/21/2004	EXAMINER	
DOBRUSIN & THENNISCH PC 29 W LAWRENCE ST SUITE 210 PONTIAC, MI 48342			KEEHAN, CHRISTOPHER M	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,887

Applicant(s)

CZAPLICKI ET AL.

Examiner

Christopher M. Keehan

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-25, 27, 29 and 32-35 is/are rejected.
- 7) ☒ Claim(s) 26, 28, 30 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/17/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16, 19, 21, 24, 32, and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 6, 7, and 16-20 of U.S. Patent No. 6,682,818 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. Claims of 6,682,818 B2 are drawn to an article of manufacture comprising the same components as the instant application, except that 6,682,818 B2 comprises a blowing agent. The claims of the instant application do not contain the blowing agent, and are therefore broader than the claims of 6,682,818 B2.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 18, 23, 27, 29, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace et al. (EP 0442178 A1). Regarding claims 15 and 34, Gerace et al. disclose a sealant material that is free of photoinitiator, the sealant material being at least partially cured prior to coating (page 5, lines 45-50), epoxy resin (page 4, line 39- page 5, line 8), a rheology modifier of an acrylate (page 4, lines 20-31), a curing agent (page 4, lines 40-42), calcium carbonate filler (page 5, lines 25-37), and a hydrocarbon of polymethyl methacrylates and ethacrylates (page 4, line 29), included in the amounts as instantly claimed (Example 1, page 6), and this composition being primed and painted in automobile applications that encompasses a first and second panel, and the sealant being applied over the first and second panel (page 5, lines 41-55).

Regarding claims 18, Gerace et al. disclose that ethyl vinyl acetate does not have to be present (page 4, lines 28-31).

Regarding claim 23, Gerace et al. do not appear to specifically disclose the property of self-leveling as instantly claimed. However, as the claimed materials are the same as that of applicant's, it appears that the composition of Koshy et al. would inherently possess the same self leveling property as claimed, absent evidence to the contrary.

Regarding claim 27, Gerace et al. disclose a polyamide curing agent, which by definition is a polyamine as it contains an NH₂ (amine) group (page 5, line 3).

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Regarding claim 29, Gerace et al. disclose a curing agent as claimed (page 5, lines 2-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 20, 22, 25, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace et al. (EP 0442178 A1). Gerace et al., as applied above, are as set forth and incorporated herein. Regarding claims 17 and 35, Gerace et al. disclose the claimed composition, in addition to the oxide (Example, page 6 of Gerace et al.) and article (as set forth above), with the exception of the amount of the filler. Gerace et al. disclose up to about 11% by weight of the adhesion promoter that can be an epoxy, which is included in the amount as claimed by applicant, and up to about 20% by weight of filler (Example 1, page 6 of Gerace et al.). Although the amount of Gerace et al. is not included in applicant's claimed range, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a variety of amounts of filler, including an amount of filler as claimed, due to the non-reactive nature of the filler.

Regarding claim 20, Gerace et al. disclose an amine curing agent (page 4, line 54-page 5, line 8).

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Regarding claim 22, Gerace et al. disclose a mineral filler (Example 1, page 6).

Regarding claim 25, Gerace et al. do not appear to specifically disclose the property of self leveling as instantly claimed. However, as the claimed materials are the same as that of applicant's, it appears that the composition of Koshy et al. would inherently possess the same self leveling property as claimed, absent evidence to the contrary.

Allowable Subject Matter

Claims 26, 28, 30, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Gerace et al. do not teach or disclose the claimed curing agents and method of partial cure as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan

December 16, 2004

*Christopher Keehan
Art Unit 1712
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